

REMARKS

Claims 11, 12, and 22 to 34 are presented for consideration. Claims 10 and 13 to 21 have been cancelled. New claims 22 to 35 have been added.

Claims 13 to 20 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,849,104 to Garcera et al. (hereinafter "Garcera"). As claims 13 to 20 have been cancelled by this amendment, Applicant respectfully submits that the rejection of these claims under 35 U.S.C. §102(b) is now moot.

Claims 10 to 12 and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,062,910 to Garcera et al. in view of the '104 patent, also to Garcera.

Claims 10 and 21 have been cancelled by this amendment. Therefore, Applicant respectfully submits that the rejection of these claims under 35 U.S.C. §103(a) is now moot.

With regard to claim 11, claim 11 requires, in part, a rod end that has "a smaller diameter than the main region".

The '104 patent provides rod ends covered with an enamel such that it has an increased thickness. See column 2, lines 20 to 27. The Action concedes that the '910 patent does not specifically teach the rod end being of smaller dimension than that of the main region of the filter element. See Page 4, Paragraph 3.

Thus, both the '910 and '104 patents provide rod ends that are thicker than the main region of the filter element. Thus, each cited patent clearly does not disclose or suggest a rod end having a smaller dimension than the main body as in claim 11.

Further, the Office Action asserts that it would have been obvious to machine a rod end to a smaller dimension than the main body of the filter element. Applicants respectfully traverse this assertion.

A reference that teaches away from the claimed invention is a significant factor to be considered in determining obviousness. See MPEP 2145.D.1; see In re Gurley, 31 USPQ2d 1130 (Fed. Cir. 1994).

The '910 patent provides:

"...each of said ends being provided with an extra thickness which is bonded to said support, wherein said extra thickness is machined in such a manner as to obtain a shoulder whose outside surface has a predetermined circularly-symmetrical shape about an axis close to that of said element." See column 2, lines 29 to 34.

Thus, the '910 patent teaches an extra thickness so that the ends can be machined to obtain the predetermined circularly-symmetrical shape.

Moreover, the '910 patent provides that:

"Attempts may be made to solve this problem by machining each end of the support so as to make it circularly symmetrical. However this has the effect of reducing the thickness of the "skin", i.e. the distance between the outer channels and the outside surface of the support." See column 2, lines 5 to 10.

Accordingly, the '910 patent states that machining the rod ends, as suggested by the Office Action, reduces the thickness of the skin, which the patent states is a problem. In direct contrast to the '910 patent, claim 11 requires that the rod end have a smaller diameter than the main region.

It is therefore submitted that the proposed combination of the '104 and '910 patents can not occur since the '910 patent teaches away from such a combination. Therefore, claim 11 is believed to be in condition for allowance.

Since claim 12 depends directly from claim 11, Applicants respectfully submit that it is also in condition for allowance for at least the same reasons set forth above with respect to claim 11. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Section 103(a) rejection of claims 11 and 12.

New claims 22 to 35 have been added to point out various aspects of the present invention. It is believed that new claims 22 to 35 are also in condition for allowance.

Independent claim 22 provides that the ceramic filter element have at least one terminal region with a smaller dimension than the main part. As previously discussed, the '104 and '910 patent provide rod ends that have an increased thickness and not the terminal region with a smaller dimension than the main part as in claim 22. Accordingly, claim 22 is believed to be in condition for allowance over the cited references.

Claims 23 to 27 depend, either directly or indirectly, from independent claim 22. Therefore, Applicants respectfully submit that these claims are also in condition for allowance.

In addition, claim 25 requires, in part, a collar that abuts a shoulder defined by the main part and the terminal region. This abutment of the shoulder and collar has the ability to take up axial thrust force that acts upon the ceramic filter element. Applicants respectfully submit that the cited references, whether taken alone or in combination, do not disclose or suggest the claimed shoulder defined by the main part and the terminal region. Rather, the shoulder in each of the cited references is defined by the extra thickness applied to the filter element. Accordingly, claim 25 is also believed to be in condition for allowance over the cited combination of references.

Further, claim 29 requires, in part, a ceramic filter element with at least one terminal region having a smaller dimension than the main part. Again, each cited reference teaches away from the claimed terminal region having a smaller dimension than the main part. Accordingly, claim 29 is patentable over the cited combination of references.

Claims 30 to 35 depend, either directly or indirectly, from independent claim 29. Therefore, Applicants respectfully submit that these claims are patentable for at least the same reasons as claim 29.

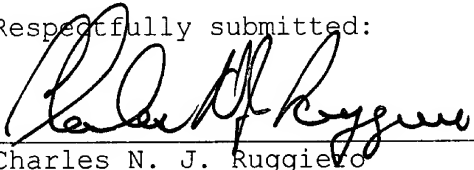
In addition, claim 35 requires that the collar abut the shoulder defined by the main part and the terminal region. Again, each cited reference, whether taken alone or in

combination, clearly does not disclose or suggest a shoulder defined between the main part and the terminal region. Accordingly, claim 3~~5~~ is patentable over the cited combination of references.

In view of the above, it is respectfully submitted that the present application is in condition for allowance. Such action is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the telephone number below for an interview.

Respectfully submitted:

July 14, 2003  
Date

  
Charles N. J. Ruggiero  
Attorney for Applicants  
Registration No. 28,468  
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.  
One Landmark Square, 10<sup>th</sup> Floor  
Stamford, CT 06901-2682  
(203) 327-4500